

REMARKS

Claims 1-3, 5-7, 20, 21, and 34-36 are pending in the application.

The office action rejects claims 1-3, 5-6, 14-18, 19-21, and 34-36 under 35 USC §103(a) as being unpatentable over EP 506,207 in view of the Merck Index. It is the examiner's position that Applicant agrees the combination of zinc chloride with 8-hydroxyquinoline is an anti-mycotic and so this renders the claimed composition obvious. There is no such agreement.

The Examiner inquires why it is not sufficient, as has been done, to establish an obviousness rejection based upon **only** equivalent use as an anti-mycotic. The Undersigned attorney appreciates this clarification. The answer is that assuming for purposes of argument that the Examiner has established a prima facie case of obviousness based upon equivalent use of anti-mycotics, this case may still be rebutted by evidence showing either a substantial increase in utility as an anti-mycotic beyond the level of utility expected in context of the prior art, or an unexpected functional difference in kind that is not uniformly repeatable in members of the class of anti-mycotics. In other words, anti-cancer activity, as is shown in the present case for a single member of the class of anti-mycotics, does not inherently extend to all other anti-mycotics. In fact, Applicant has submitted comparative data showing this function. difference, yet the examiner refuses to acknowledge that the unexpected functional difference rebuts any showing of obviousness on the basis of equivalent anti-mycotics. Moreover, the claimed material 8-hydroxyquinoline is not specifically included in the list of anti-mycotics so there is no direct suggestion to use this material in the manner of an anti-fungal. The law is clear that:

When a chemical composition is claimed, a prima facie case of obviousness under § 103 may be established by the PTO's citation of a reference to a similar composition, the presumption being that similar compositions have similar properties. *See In re Dillon*, 919 F.2d 688, 692, 16 U.S.P.Q.2D (BNA) 1897, 1901 (Fed. Cir. 1990) (en banc) ("structural similarity between claimed and prior art subject matter, . . . where the prior art gives reason or motivation to make the claimed compositions, creates a prima facie case of obviousness"), cert. denied, 500 U.S. 904, 114 L. Ed. 2d 77, 111 S. Ct. 1682 (1991). One way for a patent applicant to rebut a prima facie case of obviousness is to make a showing of "unexpected results," i.e., to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art

would have found surprising or unexpected. The basic principle behind this rule is straightforward -- that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious. The principle applies most often to the less predictable fields, such as chemistry, where minor changes in a product or process may yield substantially different results.

In re Soni, 54 F.3d 746, 750 (Fed. Cir. 1995)

It does no good for the examiner to argue obviousness on the basis of equivalent anti-mycotic functionality—unless of course the examiner also maintains that each and every material in the laundry list of anti-mycotics in EP 506,207 also functions as an anticancer agent when combined with zinc or zinc chloride.

The addition of United States Patent No. 4,780,320 as applied to claim 15 does nothing to overcome this defect in the rejection. Nothing in the combination teaches or suggests anticancer activity as shown in the current specification. The '320 patent is merely used to show prior use of a Pluronic-type of gel polymer.

The addition of pages from the Merck Index as applied to claims 16-18 to show prior use of lecithin or DMSO does nothing to overcome the basic defect. Nothing in the combination teaches or suggests anticancer activity as shown in the current specification.


The addition United States Patent No. 3,637,772 as applied to claims 19-21 and 34-36 to show prior use of nordihydroquiaretic acid and ascorbic acid does nothing to overcome the basic defect. Nothing in the combination teaches or suggests anticancer activity in the claimed composition as shown in the current specification.

The use of newly cited reference US 3,637,772 to show antioxidants in context of claims 19-21 and 34-36 does nothing to overcome the basic defect. Nothing in the combination teaches or suggests anticancer activity in the claimed composition as shown in the current specification.

The claims are patentable for the above reasons. This response is being filed with required fees for a Request for Continued Examination and Petition for Extension of Time. Applicant believes that no additional fees are due at this time. However, if any additional fees are due, the Commissioner is authorized to charge them to deposit account No. 12-0600.

Respectfully submitted,

LATHROP & GAGE LLP

By: 

Dan Cleveland, Jr., Reg. No. 36,106
4845 Pearl East Circle, Suite 201
Boulder, Colorado 80301
Telephone: (720) 931-3012
Facsimile: (720) 931-3001